Application of: David C. Silverman, et al.

Serial No.: 10/700,395

Amendment A

REMARKS

The claims in the application are now claims 1-7 and 10-98. Claims 8 and 9 have been

cancelled. Claims 1 and 49 have been amended as indicated above.

In the Office Action, dated October 4, 2006, the Examiner has rejected claims 1-9, 42—

47, 49-55, 68-73 and 96-98 and has indicated that claims 10-41, 48, 56-67 and 74-95 would be

allowable if not dependent upon a rejected base claim.

The Examiner has rejected the above noted claims under 35 U.S.C. 102(a) or, in the

alternative, under 35 U.S.C. 103 (a) citing US Patent 6,555,510 to Lamanna et al (hereinafter

Lamanna). This rejection has been overcome by the above noted amendments and cancellations

of claims. In view of the amendments, the objection to claims indicated to be allowable if not

dependent on rejected base claims has also been overcome.

Lamanna discloses a narrow species of the class of compounds now claimed as a

component of a phosphate ester functional fluid. The above noted amendments to the claims

have avoided the narrow species disclosed by Lamanna, that being a

bis(perfluoroalkanesulfonyl)imide. Such compounds as are disclosed by Lamanna are now

removed from the claims by the provisos noted by the above amended claims. First, there is no

disclosure or suggestion that anything within the scope of the filed claims other than the bis

perfluoroalkanes would be useful in a functional fluid. Insofar as the bisperfluoroaryl

compounds, it is submitted that there is a patentable distinction between the alkyl and aryl

species.

To avoid the prior art, claim 1 has been amended, (and consequently all claims dependent

thereon), so as to exclude the bis perfluoroalkyl species by requiring that when both Y and Y' are

sulfonyl, $\, X \,$ is nitrogen, $\, A \,$ is oxygen $\,$ and $\,$ n is less than 2, then only one $\, R_f \,$ can be selected from

the noted alkyl species. Such claim avoids the prior art clearly under 35 U.S.C. 102 and, because

of the narrow disclosure of Lamanna, there is no issue under 35 U.S.C. 103. As noted above the

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aryl specie is patentable distinct from the alkyl specie.

Claim 49 has been amended in the same context as claim 1 was amended, although

worded differently due to the claim structure of claim 49. The amendment of claim 49 provides

that in Formula (i) only one of $R_{\rm fl}$ and $R_{\rm f2}$ can be selected from the alkyl specie when n is 2.

Likewise, Formula (iv) has been made the subject of the second proviso such that when n is 2,

then R_{fl} is not selected from the alkyl species. Such limitations remove the rejection of claim 49

on the basis of Lamanna under both 35 U.S.C.102 and 103 on the basis of Formulas (i) and (iv).

The above remarks with respect to Lamanna in the discussion of the amendments to claim 1 are

repeated here with respect to claim 49.

All other rejected dependent claims, other than those indicated to be allowable, are now

allowable in that the limitation of the independent claims are contained in the dependent claims.

Accordingly, all of the claims now in the application are seen to be patentable over Lamanna and

therefore allowable along with those indicated by the examiner to be allowable if not dependent

upon rejected claims. In view of the above noted amendments and remarks it is submitted that

all of the claims in the application are now allowable and the examiner is respectfully requested

to withdraw the rejections noted above and to pass the application to issue.

If any issue regarding the allowability of any of the pending claims in the present

application could be readily resolved, or if other action could be taken to further advance this

application such as an Examiner's amendment, or if the Examiner should have any questions

regarding the present amendment, it is respectfully requested that the Examiner please telephone

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Applicant's undersigned attorney in this regard.

Respectfully submitted,

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